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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/596,396	08/10/2006	Stephen Terence Dunne	740116-639	6050

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ROBERTS MLOTKOWSKI SAFRAN & COLE, P.C.
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P.O. Box 10064
MCLEAN, VA 22102-8064

EXAMINER

WOOD, JONATHAN K

ART UNIT	PAPER NUMBER
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3754

NOTIFICATION DATE	DELIVERY MODE
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03/19/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/596,396	Applicant(s) DUNNE, STEPHEN TERENCE	
	Examiner JONATHAN WOOD	Art Unit 3754	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 June 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>6/12/2006</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities: ¶46, line 3 recites 'second stop 21' which appears to be a typographical error for the phrase 'second stop 22'. Appropriate correction is required.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 16-22 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent No. 6,273,304 B1 to *Hoshino* (*Hoshino*).

Hoshino shows a discharge device comprising a valve element (19) and a metering chamber (18) with an inlet valve (3) and outlet valve (27), wherein the valve element has three positions: a first position in which the outlet valve is closed and the inlet valve is open (Figure 3), an intermediate position in which both the outlet and inlet valves are closed (Figure 2), and a second position in which the outlet valve is open and the inlet valve is closed (Figure 1), wherein the valve element is actuatable between the intermediate and second positions enabling a metered dose of liquid to be discharged discontinuously (col. 5, ll. 30-45).

Regarding claims 17-20, the valve element is biased into the intermediate position by a spring (adjacent reference line 29 in Figure 3) within the metering chamber

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and is depressible against the spring from the intermediate position into the second position.

Regarding claims 17, 21 and 22, the valve element is biased into the first position by groove cam 12 at portion 13 and is depressible against the biasing force from the first position to the intermediate position by moving the projection 16 until it reaches stop 14.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over *Hoshino*.

Hoshino shows all aspects of the applicant's invention as set forth in claim 16, but does not specifically disclose that the metering chamber discharge time exceeds 2 seconds. It would have been obvious to one having ordinary skill in the art at the time of the invention to have made the discharge time of the metering chamber exceed 2

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seconds, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

7. Claims 23-30 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Hoshino* in view of US Patent No. 3,050,219 to *Sagarin et al.* (*Sagarin*).

Hoshino shows all aspects of the applicant's invention as set forth in claim 16, but does not disclose a locking means for selectively locking valve actuation between the intermediate and second positions. However, *Sagarin* shows a pressurized dispenser with a locking means (36) associated with the actuation member which prevents valve actuation. It would have been obvious to one having ordinary skill in the art at the time of the invention, under the teachings of *Sagarin*, to have manufactured the discharge device of *Hoshino* with the locking actuating member of *Sagarin* in place of actuation member 40 in order to avoid inadvertent depression of the valve stem and subsequent loss of contents (*Sagarin*, col. 1, ll. 17-28). This combination would result in the dispensing device selectively locking between the intermediate and second positions.

Regarding claims 24 and 27, the locking means has a first stop (*Sagarin*, 42) which defines the intermediate position.

Regarding claims 25 and 32, the actuating member is rotatable between locked and unlocked states (*Sagarin*, col. 4, ll. 30-32).

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Regarding claim 26, *Hoshino* as modified by *Sagarin* shows a second locking means (*Hoshino*, 16, Figure 4) for locking movement from the intermediate position to the first position.

Regarding claim 27, the second locking means has a stop (*Hoshino*, 14) preventing movement of the valve element from the intermediate position to the first position by a biasing force (*Hoshino*, 7).

Regarding claim 28, the locking element 16 is rotatable for locking and unlocking the second locking means (*Hoshino*, Figure 4).

Regarding claim 30, *Hoshino* as modified by *Sagarin* further comprises an actuation member (*Sagarin*, 28 with 44), wherein the actuation member has a portion (*Sagarin*, 44) for engaging into a recess (*Sagarin*, 42) to form the first locking means.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- US Patent No. 5,632,421 to *Colombo* discloses a metered aerosol valves with three distinct positions like that of applicant's invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JONATHAN WOOD whose telephone number is (571)270-7422. The examiner can normally be reached on Monday through Friday, 7:30 AM to 5 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Shaver can be reached on (571)272-4720. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JKW/

Examiner, Art Unit 3754

/Kevin P. Shaver/

Supervisory Patent Examiner, Art Unit 3754